

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Teruhiko Hagiwara	Art Unit:	2859
Serial No.:	09/803,819	Patent No.:	7,135,862 B2
Filed:	March 12, 2001	Issued:	November 14, 2006
For:	NMR LOGGING USING TIME-DOMAIN AVERAGING	Attorney Docket No:	7420-081-999 (020243-999080)

**REQUEST FOR RECONSIDERATION OF PETITION TO CORRECT FILING DATE AND
DATE-IN DISCREPANCY UNDER 37 C.F.R. §1.10(c)**

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of a petition that was dismissed by the Office of Petitions on January 3, 2008. Petitioner received the decision on January 7, 2008. Petitioner thanks Attorney Charlema Grant of the Office of Petitions for the helpful telephone call of January 9, 2008, and responds below.

Background

On April 23, 2007, petitioner submitted a petition to correct the filing date and date-in discrepancy under 37 C.F.R. §1.10(c) and to issue a certificate of correction for the above-identified patent. *See Exhibit A.* On January 3, 2008, petitioner received a decision from the Patent Office dismissing the April 23, 2007 petition (“the Decision”). The Decision is attached as Exhibit B. According to the Decision, a petition under 37 C.F.R. §1.10(c) has to satisfy three requirements to be granted:

- (1) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
- (2) include a showing that the number of the “Express Mail” mailing label was placed on

each piece of correspondence prior to the original mailing; and

- (3) include a true copy of the “Express Mail” mailing label showing the “date in” or other official notation by the USPS.

According to the Decision, the petition was rejected for “lack[ing] item (1) above,” because the “Petitioner has failed to establish that this petition was filed promptly.” The Decision further stated that “[a] review of the record shows that the request for an earlier filing date was not raised throughout the prosecution of the application. The issue of the filing date was not raised until after the patent issued. A justification for the delay in seeking the correction of the filing date has not been provided. Further, the Office has limited jurisdiction once an application has issued as a patent.”

Petitioner respectfully requests a reconsideration of the Decision, because (1) the error in according an incorrect filing date was not corrected during the pendency of the application because the prosecuting attorneys and agents did not become aware of the discrepancy until the patent had issued, (2) the petition was promptly filed once the patent issued and the patentee’s new law firm became aware of the error made by the Patent Office, and (3) the petition was filed approximately one month after the petition’s draftee became aware of the error made by the Patent Office. Each of these grounds is addressed in turn.

Prosecution of patent application No. 09/803,819

The ’819 application was filed by the law firm of Pennie and Edmonds on March 12, 2001 via the U.S. Postal Service bearing a proper Express Mail label. *See Exhibit A* and attachments therein. The Patent Office accorded the ’819 application an incorrect filing date of March 13, 2001 and the error was perpetuated throughout prosecution, culminating in issued patent No. 7,135,862 B2, also bearing the incorrect March 13, 2001 filing date. Details regarding the filing of the ’819 application, and the correspondence to and from the Patent Office are included in Exhibit A.

In particular, on April 25, 2001, the law firm of Pennie & Edmonds received a filing receipt in the ’819 application bearing the incorrect March 13, 2001 filing date. *See Exhibit C*. As part of ordinary procedure, the Pennie & Edmonds docketing department reviewed the filing receipt, mistakenly checking off March 13, 2001 as the correct filing date. Please see Exhibit C

for checkmarks left from the review process. Because no error was flagged during this review process, the prosecuting attorneys and agents were not notified of the error, and did not correct the filing date discrepancy during the pendency of the application. The prosecuting attorneys and agents relied on erroneous Patent Office records and information systems such as PAIR, perpetuating the error throughout prosecution of the '819 application. For this reason, the filing date discrepancy was not, and could not have been corrected during the pendency of the '819 application.

Issuance of U.S. patent No. 7,135,862 B2

The law firm of Pennie and Edmonds ceased to exist on December 31, 2003, and the above-identified application was transferred to the law firm of Jones Day. On October 31, 2006, Jones Day received an Issue Notification regarding the '862 patent. *See Exhibit D.* The standard Issue Notification form did not include the filing date of the '819 application, and at this time no one at Jones Day was aware of the filing date discrepancy.

The '862 patent issued on November 14, 2006, and upon receiving the physical copy of the '862 patent, the docketing department at Jones Day reviewed the patent for any errors. The docketing department compared the filing date listed on the face of the '862 patent with internal Jones Day records, and noticed the filing date discrepancy. Subsequently, the docketing department notified the prosecuting attorneys and agents of the discrepancy, and the petition was filed on April 23, 2007.

Here, it may be helpful to address the grounds under which the April 23, 2007 petition was dismissed. As mentioned above, the petition was dismissed for not being “filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date.” Petitioner has already explained why the petition could not have been filed during the pendency of the application, namely because the prosecuting attorneys and agents were not aware of the discrepancy. Indeed, during the telephone conversation with Petitions Attorney Charlema Grant on January 9, 2008, petitioner noted that the error was not discovered until after the patent had issued, as stated on the original petition filed on April 23, 2007. In reply, Petitions Attorney Grant noted that the Patent Office follows an internal presumption that a petition under 37 C.F.R. §1.10(c) is promptly filed if the petition is filed

within two months after the person becomes aware of the filing date discrepancy. However, neither the text of 37 C.F.R. §1.10, nor MPEP §513 describing the rule make any mention of the two-month presumption of promptness. *See Exhibits E and F.* In contrast, certain Patent Office Rules dealing with petitions explicitly set forth a two-month filing deadline. *See* 37 C.F.R. §1.181 (“Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.”) However, 37 C.F.R. §1.10(c) does not set a hard filing deadline. Had petitioner been aware of the internal two-month PTO presumption, the two-month deadline would have been immediately docketed, and all responsible attorneys and agents would have received constant reminders.

Thus, petitioner had no notice of the internal PTO presumption, neither from the C.F.R., the MPEP, or the PTO website. Petitioner contends that the April 23, 2007 petition was filed promptly, and respectfully requests that the Decision be reconsidered with a view toward grant, and the attached certificate of correction attached as Exhibit G be issued.

Filing of the petition

With regard to the petition’s filing date, petitioner respectfully submits that the petition was filed approximately one month after its draftee became aware of the date-in discrepancy. The following chart, retrieved from Jones Day’s document management system, is a record of the certificate of correction’s document history from creation through filing. Please note that the certificate document was created on March 23, 2007. The actual petition document was created on the same date. As already discussed, the entire petition was filed only a month later, on April 23, 2007, allowing for the undersigned to investigate the pertinent facts.

User	Applicati .	Activity	Date - Time	Duration	Pages Prin..	Location	Comments
JP010585	WINWORD	Modify	4/23/2007 11:26:47 A	0:0:0	0	NY-G27-7KP	
JP010585	WINWORD	Checkin	4/23/2007 11:26:47 A	0:4.16	0	NY-G27-7KP	
JP010585	Microsoft Wo	Print	4/23/2007 11:26:32 A	0:0:0	0	NY-G27-7KP	
JP010585	MANAGE32	Checkout	4/23/2007 11:22:31 A	0:0:0	0	NY-G27-7KP	
JP010585	WINWORD	Modify	4/23/2007 9:14:26 AM	0:0:0	0	NY-G27-7KP	
JP010585	WINWORD	Checkin	4/23/2007 9:14:26 AM	0:20:52	0	NY-G27-7KP	
JP010585	Microsoft Wo	Print	4/23/2007 9:14:19 AM	0:0:0	0	NY-G27-7KP	
JP010585	MANAGE32	Checkout	4/23/2007 8:53:34 AM	0:0:0	0	NY-G27-7KP	
JP006649	MANAGE32	View	4/1/2007 2:21:23 PM	0:0:0	0	NACX11MS	
JP006615	MANAGE32	View	3/28/2007 4:24:16 PM	0:0:0	0	NY-G27-HM0	
JP010585	WINWORD	Checkin	3/23/2007 4:35:59 PM	0:3:56	0	NY-G27-7KP	
JP010585	WINWORD	Modify	3/23/2007 4:35:58 PM	0:0:0	0	NY-G27-7KP	
JP010585	WinWord	Checkin	3/23/2007 4:32:03 PM	0:0:16	0	NY-G27-7KP	
JP010585	WinWord	Checkout	3/23/2007 4:32:03 PM	0:0:0	0	NY-G27-7KP	
JP010585	WINWORD	Create	3/23/2007 4:31:47 PM	0:0:0	0	NY-G27-7KP	
JP010585	WINWORD	Checkout	3/23/2007 4:31:47 PM	0:0:0	0	NY-G27-7KP	

Certificate of Correction

In view of the above, Petitioner respectfully submits that the original petition was filed within approximately one month of the draftee's becoming aware of the filing discrepancy, which complies with the two-month promptness presumption internal to the Office of Petitions. For all of the above reasons, petitioner respectfully requests that the Decision be reconsidered, and the petition filed on April 23, 2007 be granted.

Conclusion

In view of the above, petitioner respectfully requests that the Decision dismissing the April 23, 2007 petition be reconsidered and the certificate of correction attached as Exhibit G be issued. No fees are believed to be due for this submission. Should any fees be required, however, please charge such fees to Jones Day Deposit Account No. 50-3013. The reviewing attorney is invited to call the undersigned attorney with any additional questions.

Date: February 27, 2008

Respectfully submitted,

Ognjan V. Shentov

38,051

(Reg. No.)

JONES DAY

222 East 41st Street

New York, New York 10017-6702

(212) 326-3939

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	Teruhiko Hagiwara	Art Unit:	2859
Serial No.:	09/803,819	Patent No.:	7,135,862 B2
Filed:	March 12, 2001	Issued:	November 14, 2006
For:	NMR LOGGING USING TIME-DOMAIN AVERAGING	Attorney Docket No:	7420-081-999 (020243-999080)

**PETITION TO CORRECT FILING DATE AND DATE-IN DISCREPANCY
UNDER 37 C.F.R. §1.10(c)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

cc: Certificate of Correction Branch

Sir:

In accordance with 37 C.F.R. §1.10(c), Patentee hereby requests a correction of an error in the filing date accorded to the above-identified application, discovered after the patent had issued.

The Patent Office erred in according this application a March 13, 2001 filing date, because the application was submitted via the U.S. Postal Service on March 12, 2001, bearing a proper Express Mail label. The error was perpetuated throughout prosecution, and the incorrect March 13, 2001 filing date appeared as item (22) on the first page of the above-identified patent.

It is believed that the Patent Office can correct the error by granting this petition to establish March 12, 2001 as the correct filing date for the above-identified patent application, and issuing the attached certificate of correction.

The facts are as follows:

Patent application Serial No. 09/803,819 ("the '819 application") was filed on March 12, 2001, and matured into the above-identified U.S. Patent No. 7,135,862.

Pursuant to 37 C.F.R. §1.10, the '819 application was filed with an Express Mail label and deposited with the United States Postal Service "Express Mail Post Office to Addressee" on March 12, 2001. Patentee encloses herewith the following documents that evidence that the '819 application was properly filed under 37 C.F.R. § 1.10 on March 12, 2001:

(Exhibit A) copy of a United States Postal Service Express Mail label bearing March 12, 2001 as the "Date In" and the Express Mail number EL 501 637 971 US, which is also date-stamped March 12, 2001 by the Grand Central Station Post Office;

(Exhibit B) copy of a return post card for the '819 application which bears the filing particulars of the '819 application, including Express Mail number EL 501 637 971 US, and which indicates March 12, 2001 as the mailing date, but which is erroneously stamped by the United States Patent and Trademark Office with the date March 13, 2001;

(Exhibit C) copy of the Utility Patent Application Transmittal bearing Attorney Docket No. 7420-0081-999, which was filed with the '819 application and bears the same Express Mail Number EL 501 637 971 US, indicating a deposit date of March 12, 2001;

(Exhibit D) copy of the Pennie & Edmonds Docketing Department Log, executed and dated by Phil Mannino on March 12, 2001 for a package that was addressed to the Assistant Commissioner for Patents, bearing Express Mail No. EL 501 637 971 US. Page 2 of the Log shows that the application bearing docket No. 7420-081 was among the contents of the package mailed on March 12, 2001; and

(Exhibit E) copy of the front page of issued U.S. Patent No. 7,135,862 B2, bearing an incorrect filing date of March 13, 2001 at item (22).

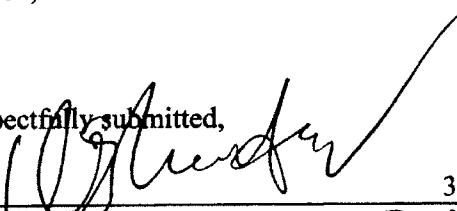
The Express Mail Number on Exhibits B and C as described above was placed on the respective document prior to the original mailing by Express Mail. Attached Exhibits A through E are true copies of the original Express Mail mailing label, return postcard receipt, originally mailed correspondence, docketing log, and the front page of the issued patent.

Since the attached documents evidence the correct March 12, 2001 filing date, and satisfy the requirements set forth in 37 C.F.R. §1.10(c), Patentee respectfully requests that this petition be granted, and that the attached certificate of correction be issued.

No fee is believed to be due for this petition, or for the certificate of correction, since the error was made by the Patent and Trademark Office. Should any fees be required, however, please charge such fees to Jones Day Deposit Account No. 50-3013. Accordingly, patentees respectfully request a grant of this petition, and an issuance of the attached certificate of correction.

Date: April 23, 2007

Respectfully submitted,


Ognjan V. Shentov

38,051
(Reg. No.)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,135,862 B2
DATED : November 14, 2006
INVENTOR(S) : Teruhiko Hagiwara

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

At item "(22) Filed:" on the face of the patent, replace --Mar. 13, 2001-- with --Mar. 12, 2001--.

MAILING ADDRESS OF SENDER:
JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939

PATENT NO. 7,135,862 B2
No. of add'l. copies
@ 30¢ per page
=> 10
NYI-3976090v1

EXHIBIT A

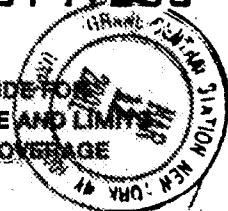
**POST OFFICE
TO ADDRESSEE**



EL501637921US

EL501637921US

SEE REVERSE SIDE FOR
SERVICE GUARANTEE AND LIMITS
ON INSURANCE COVERAGE



ORIGIN (POSTAL USE ONLY)		Day of Delivery	Flat Rate Envelope
PO ZIP Code 10017		<input checked="" type="checkbox"/> Now <input type="checkbox"/> Second	<input type="checkbox"/>
Date In 3/12/01		<input checked="" type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Postage \$ 3615
Time In 10:51 AM		<input type="checkbox"/> 1st Day <input checked="" type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee
Weight 10 lbs. 80 oz.		Int'l Alpha Country Code	COD Fee Insurance Fee
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday		Acceptance Code (check)	Total Postage & Fees \$ 3515

NETTING OF PAYMENT: Express Mail Corporate Acct. No. _____	WAMER OF SERVICE (Domestic Only): Addressee waives right of refusal if delivery is refused or delayed due to my failure to provide a signature or acknowledge receipt of my article. I also agree that article can be left in lecture location and I authorize that carrier to leave my article at my address if no one is home. I understand that delivery is guaranteed if I provide a valid address and sign for delivery.
Federal Agency Acct. No. or Postal Service Acct. No. _____	NO DELIVERY: <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday <input type="checkbox"/> Work Day

FROM: (PLEASE PRINT) **PENNIE & EDMONDS LLP**
155 AVENUE OF THE AMERICAS
11TH FL
NEW YORK **NY 10036-2711**

TO: (PLEASE PRINT) **ASSISTANT COMMISSIONER**
FOR PATENTS
WASHINGTON **DC 20231-9999**

PRESS HARD.
You're reading it right. FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.gov

EXHIBIT B

Express Mail No. EL 504 637 971 US First Class Mail () C-
Date Mailed March 12, 2001
Ser. No. to be assigned Filed HEREWITH
Inventor/Mark Teruhiko Nagiwara
For NMR LOGGING USING TIME-DOMAIN AVERAGING

Utility Patent Application Transmittal cover sheet.

Patent Application Fee Value Sheet w/ Fee & photocopy of same.

Patent Application consisting of:

13 pages of Specification including Abstract;

28 Claims;

8 Sheets of Drawings - Figs. 1-8; and
executed Declaration for Non-provisional Patent Application.

Recordation Form Cover Sheet w/ Fee and
executed Assignment.

Executed Power of Attorney by Assignee.

File No. 7420-081-999 FEM/OVS
100-0000000000000000 Sender 100-0000000000000000

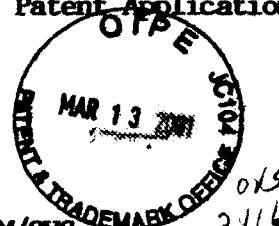


EXHIBIT C

Please type a plus (+) inside this box -

PTO/SB/29 (12/97)

Approved for use through 09/30/00. OMB 0651-0032

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.	7420-081-999	Total Pages	23
First Named Inventor or Application Identifier			
Teruhiko Hagiwara			
Express Mail Label No.		EL 501 637 971 US	

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

1. Fee Transmittal Form
Submit an original, and a duplicate for fee processing
2. Specification
(preferred arrangement set forth below)
 - Descriptive title of the Invention
 - Cross Reference to Related Applications
 - Statement Regarding Fed sponsored R&D
 - Reference to Microfiche Appendix
 - Background of the Invention
 - Brief Summary of the Invention
 - Brief Description of the Drawings *(if filed)*
 - Detailed Description of the Invention (including drawings, *if filed*)
 - Claim(s)
 - Abstract of the Disclosure
3. Drawing(s) *(35 USC 113)* [Total Sheets 8]
4. Oath or Declaration [Total Sheets 2]
 - a. Newly executed (original or copy)
 - b. Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 17 completed)
[Note Box 5 below]
 - i. **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.83(d)(2) and 1.33 (b).
5. Incorporation By Reference *(useable if Box 4b is checked)*
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
17. If a CONTINUING APPLICATION, check appropriate box and supply the requisite information:
 Continuation Divisional Continuation-in-part (CIP) of prior application No: filed .

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

6. Microfiche Computer Program *(Appendix)*
7. Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)
 - a. Computer Readable Copy
 - b. Paper Copy *(identical to computer copy)*
 - c. Statement verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

8. Assignment Papers (cover sheet & document(s))
9. 37 CFR 3.73(b) Statement Power of Attorney
(when there is an assignee)
10. English Translation Document *(if applicable)*
11. Information Disclosure Statement (IDS)/PTO-1449 Copies of IDS Citations
12. Preliminary Amendment
13. Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
14. Small Entity Statement filed in prior application, Statement(s) Status still proper and desired
15. Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. Other: Executed Power of Attorney by Assignee and
Exclusion of Inventor(s) Under 37 C.F.R. 3.71

18. CORRESPONDENCE ADDRESS

Customer Number or Bar Code Label

20583  Insert Customer No. or Attach bar code label here

or Correspondence address below

NAME

ADDRESS

CITY

COUNTRY

STATE

ZIP CODE

TELEPHONE

FAX

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

EXHIBIT D

EL501637971US

DATE: MARCH 12, 2001

THE EXPRESS MAIL NUMBER OF THE DAY IS: EL 501 637 971 US

THE PERSON TAKING EXPRESS MAIL
TO THE POST OFFICE IS: PHIL MANNINO

EXPRESS MAIL CERTIFICATION

"Express Mail" label No. EL 501 637 971 US

Date of Deposit MARCH 12, 2001 I hereby certify that the below-listed papers or fees were inserted into a package that was addressed to the Assistant Commissioner For Patents, Washington, D.C. 20231 and was deposited by me with the United States Postal Service "Express Mail Post Office Addressee" service under 37 C.F.R. 1.10 on the date indicated above.

Signature

Date: 3/12/01

GAO	9661-011 <i>W</i>	UTILITY PATENT APPLN. TRANSMITTAL, 33 PAGES & ABSTRACT, 47 CLMS., 16 DWGS, DECLARATION, FEE CALCULATION W/COPY, POWER OF ATTY BY ASSIGNEE AND EXCLUSION OF INVENTORS, SMALL ENTITY STATEMENT	+ <i>r</i>	
MORRIS, F SHENTOV	7420-065 <i>J</i>	ISSUE FEE TRANSMITTAL W/COPY	+ <i>r</i>	<i>GIVE CARDO TO</i>
POISSANT AZRIN	7960-137	PRELIMINARY AMENDMENT	+ <i>r</i>	
MARSHALL ROTHERY	618-860 <i>C</i>	PET. FOR EXT. OF TIME UNDER 37 CFR 1.97(d)(2), AMENDMENT (RESPONSE TO OA DATED 1/11/01), INFORMATION DISCLOSURE STATEMENT W/REFS.	+ <i>r</i>	
YOKOYAMA <small>due to customs inspection, overnight delivery to trustee, addressee's claim to d return information, 2) was a second attempt and failed, 3) was a military Express Mail and, for international coverage, terms of office. # copies are of federal regulation and IMA provide, in or lifting. Coverage charged for an</small>	5868-008 <i>C</i>	PET. FOR EXT. OF TIME W/COPY, AMENDMENT (RESPONSE TO OA DATED 10/13/00)	+ <i>r</i>	
POISSANT PASQUALE <small>fixed for the insurance</small>	8657-037 <i>C</i>	NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES, TRANSMITTAL LTR, SEQUENCE LISTING	+ <i>r</i>	
POISSANT PASQUALE	8657-038	NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING	+ <i>r</i>	

INSOGNA GRAHAM	10624-009	INFORMATION DISCLOSURE STATEMENT, REVISED PTO FORM 1449 W/REF.AR-AT	X	OK
SHENTOV	7420-081 <i>WJ</i>	UTILITY PAT APPLN TRANS SHEET, PAT APPLN SPEC.13 PGS.28 CLAIMS, 8 SHEETS OF DRAWINGS, EXECUTED DECL, POWER OF ATTORNEY & ASSIGNMENT, RECORDATION FORM COVER SHEET W/FEE	X	OK
HOROWITZ	10211-003 <i>QJ</i>	AMENDMENT, APPENDIX A, B & C, FEE TRANSMITTAL SHEET (IN DUPLICATE)	X	OK



EXHIBIT E



US007135862B2

(12) **United States Patent**
Hagiwara(10) **Patent No.:** US 7,135,862 B2
(45) **Date of Patent:** Nov. 14, 2006(54) **NMR LOGGING USING TIME-DOMAIN AVERAGING**

4,728,892 A	3/1988	Vinegar et al.	324/309
4,933,638 A	6/1990	Kenyon et al.	324/303
4,939,648 A	7/1990	O'Neill et al.	364/422
5,023,551 A	6/1991	Kleinberg et al.	324/303
5,055,787 A	10/1991	Kleinberg et al.	324/303
5,055,788 A	10/1991	Kleinberg et al.	324/303
5,122,746 A	6/1992	King et al.	324/307
5,212,447 A	5/1993	Paltiel	324/300
5,280,243 A	1/1994	Miller	324/303
5,291,137 A	3/1994	Freedman	324/303
5,309,098 A	5/1994	Coates et al.	324/303
5,350,925 A	9/1994	Watson	250/269.3

(75) Inventor: **Teruhiko Hagiwara**, Houston, TX (US)

(73) Assignee: **Halliburton Energy Services, Inc.**,
Houston, TX (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 23 days.

(21) Appl. No.: **09/803,819**(22) Filed: **Mar. 13, 2001**(65) **Prior Publication Data**

US 2002/0163334 A1 Nov. 7, 2002

EP 0 649 035 B1 4/1995

(51) **Int. Cl.**
G01V 3/00 (2006.01)

(Continued)

(52) **U.S. Cl.** **324/303**

FOREIGN PATENT DOCUMENTS

(58) **Field of Classification Search** 324/300,
324/303, 307, 309, 314; 702/79, 179
See application file for complete search history.

(Continued)

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U.S. PATENT DOCUMENTS

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3,402,344 A	9/1968	Brown et al.		
3,617,867 A	11/1971	Herzog	324/0.5
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3,667,035 A	5/1972	Slichter	324/0.5 R
3,881,651 A *	5/1975	Wilhelm, Jr.	700/34
4,389,613 A *	6/1983	Brown	324/303
4,412,178 A *	10/1983	Brown	324/303
4,412,179 A *	10/1983	Brown	324/303
4,536,714 A	8/1985	Clark	324/338
4,710,713 A	12/1987	Strikman	324/303
4,717,876 A	1/1988	Masi et al.	324/303
4,717,877 A	1/1988	Taicher et al.	324/303
4,717,878 A	1/1988	Taicher et al.	324/303

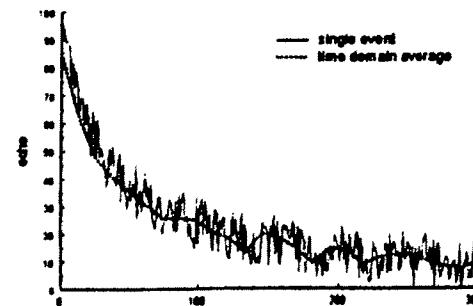
Akkurt et al., "Selection of Optimal Acquisition Parameters for MRIL Logs," SPWLA 37th Annual Logging Symposium, Jun. 16-19, 1996.

Primary Examiner—Diego Gutierrez
Assistant Examiner—Dixomara Vargas
(74) **Attorney, Agent, or Firm—Jones Day**

(57) **ABSTRACT**

Method for data acquisition and processing, which uses time-domain averaging to increase the signal to noise ratio (SNR) in single-event measurements. In a preferred embodiment, NMR echo-trains obtained using high-speed NMR logging are provided, the echo trains are time-domain averaged, preferably in real-time, over one or more time intervals to sharpen the spatial resolution of the logging tool and/or to increase the signal to noise ratio (SNR) of the data train.

21 Claims, 8 Drawing Sheets



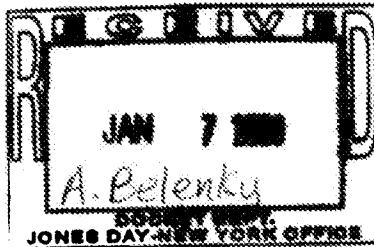
Time-domain averaged echo-train data.

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

JONES DAY
222 EAST 41ST ST
NEW YORK NY 10017



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

JAN 03 2008

OFFICE OF PETITIONS

In re Patent No. 7,135,862
Issue Date: November 14, 2006
Application No. 09/803,819
Filed: March 13, 2001
Attorney Docket No. 7420-081-999

: DECISION DISMISSING
: PETITION UNDER 37 CFR 1.10(c)

This is a decision on the petition filed April 23, 2007, which is properly treated as a petition under 37 CFR 1.10(c) requesting that the above-identified application be considered as filed on March 12, 2001, which is the "date-in" or other official USPS notation on the Express Mail Mailing Label, instead of the currently accorded filing date of March 13, 2001.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely (see 37 CFR 1.181(f)). No extensions of time pursuant to the provisions of 37 CFR 1.136 are permitted.

37 CFR 1.10(c) sets forth procedures for filing a petition to the Director for a filing date as of the date of deposit with the USPS, where there is a discrepancy between the filing date initially accorded by the Office and the "date in" entered by the USPS or other official USPS notation.

To be grantable, a petition must:

- (1) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
- (2) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing; and
- (3) include a true copy of the "Express Mail" mailing label showing the "date in" or other official notation by the USPS.

This petition lacks item (1) above.

Petitioner requests the filing date of March 12, 2001 on the basis that there is a discrepancy between the filing date the USPTO has currently accorded this application and the "date-in" or other official USPS notation on the "Express Mail" mailing label.

Petitioner has failed to establish that this petition was filed promptly. A review of the record shows that the request for an earlier filing date was not raised throughout the prosecution of the application. The issue of the filing date was not raised until after the patent issued. A justification for the delay in seeking the correction of the filing date has not been provided. Further, the Office has limited jurisdiction once an application has issued as a patent.

Accordingly, the request to correct the filing date is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3215.



Charlema Grant
Petitions Attorney
Office of Petitions

EXHIBIT C



UNITED STATES PATENT AND TRADEMARK OFFICE

O. V. SKERSTAD
1725

COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/803,819 /	03/13/2001 /	2862 /	934	7420-081-999	8	28	4

CONFIRMATION NO. 1331

20583
 PENNIE AND EDMONDS
 1155 AVENUE OF THE AMERICAS
 NEW YORK, NY 100362711

FILING RECEIPT



OC000000005988556

Date Mailed: 04/19/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Teruhiko Hagiwara, Houston, TX;

Domestic Priority data as claimed by applicant

Foreign Applications

If Required, Foreign Filing License Granted 04/19/2001

Projected Publication Date: 09/19/2002

Non-Publication Request: No

Early Publication Request: No

Title

NMR logging using time-domain averaging ✓

REFERRED TO _____
REC'D
APR 25 2001
Pennie & Edmonds
O.K. for filing _____

Preliminary Class

324

Data entry by : ZEWDIE, BIZUAYEHU

Team : OIPE

Date: 04/19/2001



**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 36 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15 (b).

PLEASE NOTE the following information about the Filing Receipt:

- The articles such as "a," "an" and "the" are not included as the first words in the title of an application. They are considered to be unnecessary to the understanding of the title.
- The words "new," "improved," "improvements in" or "relating to" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- The title may be truncated if it consists of more than 600 characters (letters and spaces combined).
- The docket number allows a maximum of 25 characters.
- If your application was submitted under 37 CFR 1.10, your filing date should be the "date in" found on the Express Mail label. If there is a discrepancy, you should submit a request for a corrected Filing Receipt along with a copy of the Express Mail label showing the "date in."
- The title is recorded in sentence case.

Any corrections that may need to be done to your Filing Receipt should be directed to:

Assistant Commissioner for Patents
Office of Initial Patent Examination
Customer Service Center
Washington, DC 20231

EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE

17420-081-999

A. Kennedy

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,819	11/14/2006	7135862	7420-081-999	1331

20583 7590 10/25/2006

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

Confirm Patent Term Adj.

1-14-07

ISSUE NOTIFICATION

Terry
020243-998382

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 23 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

APPLICANT(s) (up to 18 names are included below, see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Teruhiko Hagiwara, Houston, TX;

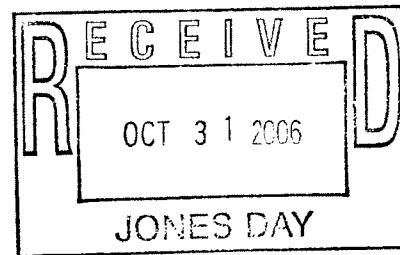


EXHIBIT E

§ 1.10 Filing of correspondence by “Express Mail.”

(a)(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the “Express Mail Post Office to Addressee” service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the “date in” on the “Express Mail” label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the “Express Mail” mailing label with the “date-in” clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an “Express Mail” drop box) do so at the risk of not receiving a copy of the “Express Mail” mailing label with the desired “date-in” clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the “Express Mail” mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the “Express Mail Post Office to Addressee” service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the “date-in” on the “Express Mail” mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the “date-in” on the “Express Mail” mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by “Express Mail;” and

(3) The petition includes a true copy of the “Express Mail” mailing label showing the “date-in,” and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the “Express Mail Post Office to Addressee” service of the USPS, who can show that the “date-in” on the “Express Mail” mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by “Express Mail”; and

(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the “Express Mail Post Office to Addressee” service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the “Express Mail Post Office to Addressee” service of the USPS.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the “Express Mail Post Office to Addressee” service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the “Express Mail” mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by “Express Mail”;

the Director (a) if the correspondence is deposited in the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

(g) Any person who mails correspondence addressed as set out in § 1.1 (a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence returned by the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the return of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing

label showing the "date-in"; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in "Express Mail" service.

(h) Any person who attempts to mail correspondence addressed as set out in § 1.1 (a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service.

(i) Any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or

emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

- (1) The petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service;
- (2) The petition includes the original correspondence or a copy of the original correspondence; and
- (3) The petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

[48 FR 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983, paras. (a) & (c), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a)-(c) revised and paras. (d) - (f) added, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 67 FR 36099, May 23, 2002, effective June 24, 2002; paras. (c), (d), (d)(3), (e) & (e)(4) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(1) revised, 68 FR 48286, Aug. 13, 2003, effective Sept. 12, 2003; paras. (g) through (i) added, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004]

RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

§ 1.11 Files open to the public.

(a) The specification, drawings, and all papers relating to the file of: A published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). If an application was published in redacted form pursuant to § 1.217, the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § 1.217 have been met in the application; and

the application is still pending. See § 2.27 of this title for trademark files.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

(c) All requests for reexamination for which all the requirements of § 1.510 or § 1.915 have been satisfied will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Director pursuant to § 1.520 will also be announced in the *Official Gazette*. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Director initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

(e) Except as prohibited in § 41.6 (b), the file of any interference is open to public inspection and copies of the file may be obtained upon payment of the fee therefor.

[42 FR 5593, Jan. 28, 1977; 43 FR 28477, June 30, 1978; 46 FR 29181, May 29, 1981, para. (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (a), (b) and (e), 50 FR 9278, Mar. 7, 1985, effective May 8, 1985; para. (e) revised, 60 FR 14488, Mar. 17, 1995, effective Mar. 17, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (e) revised, 69 FR 49959, Aug. 12, 2004, effec-

EXHIBIT F

should inspect the paper to ensure that the benefits of 37 CFR 1.8 or "Express Mail" benefits under 37 CFR 1.10 are not accorded in error. If the paper contains a certificate of mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10), the words "HAND DELIVERED" should be written adjacent to the date stamp.

Applicant should be notified in the next Office action when a paper containing a Certificate of Mailing has been denied the benefits under 37 CFR 1.8 or a paper containing an "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) is denied benefits under 37 CFR 1.10 by including, for example, form paragraph 5.04.

¶ 5.04 Benefit of Certificate of Mailing Denied

The [1] filed [2] is not entitled to the benefits of 37 CFR 1.[3] since it was not deposited with the U. S. Postal Service for delivery to the U.S. Patent and Trademark Office. Therefore, the date of receipt in the U.S. Patent and Trademark Office has been used to determine the timeliness of the paper.

Examiner Note:

1. This form paragraph is to be used in those situations where correspondence contains a Certificate of Mailing under 37 CFR 1.8 or requests the benefit of "Express Mail" under 37 CFR 1.10, but the correspondence was not actually deposited with the U. S. Postal Service.
2. In bracket 3, insert --8-- or --10--, as appropriate.

Misuse of a Certificate of Mailing under 37 CFR 1.8 or improperly claiming the benefit of 37 CFR 1.10 which appears to be more than a one-time, inadvertent error should be brought to the attention of the Office of Enrollment and Discipline.

IV. ORIGINAL MAILED PAPER NOT DELIVERED

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. mail or transmitted by facsimile, but never received by the U.S. Patent and Trademark Office. In the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director. The statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

>37 CFR 1.8(b) permits a party to notify the Office of a previous mailing, or transmitting, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting of the corre-

spondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and a statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission. Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence.

Before notifying the Office of a previously submitted correspondence that appears not to have been received by the Office, applicants are encouraged to check the private Patent Application Information Retrieval (PAIR) System to see if the correspondence has been entered into the application file.<

513 Deposit as Express Mail with U.S. Postal Service [R-3]

35 U.S.C. 21. Filing date and day for taking action.

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

37 CFR 1.6. Receipt of correspondence.

(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this

section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) [Reserved]

37 CFR 1.10. Filing of correspondence by "Express Mail".

(a)(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:<

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

>

(g) Any person who mails correspondence addressed as set out in § 1.1 (a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence returned by the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the return of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in"; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in "Express Mail" service.

(h) Any person who attempts to mail correspondence addressed as set out in § 1.1 (a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service.

(i) Any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to

consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service;

(2) The petition includes the original correspondence or a copy of the original correspondence; and

(3) The petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.<

The statutory authority for the granting of a filing date based on the date of deposit for correspondence sent by "Express Mail" and received by the Office is found in section 21(a) of Title 35 of the United States Code.

The specific rule for obtaining a filing date as of the date of deposit in "Express Mail" (rather than the date of receipt at the Office) is 37 CFR 1.10.

35 U.S.C. 21(a) is limited to correspondence deposited with the United States Postal Service (USPS). The procedure in 37 CFR 1.10 is limited to correspondence deposited in the "Express Mail Post Office to Addressee" service of the USPS. There are no similar provisions and no similar benefit can be obtained for correspondence deposited in International Express Mail.

I. EFFECTIVE DATE, WEEKENDS & HOLIDAYS

Effective December 2, 1996, 37 CFR 1.6(a)(2) provides that correspondence deposited as "Express Mail" in accordance with 37 CFR 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia. 37 CFR 1.10 provides a procedure for assigning the date on which any paper or fee is deposited as "Express Mail" with the USPS as the filing date of the paper or fee in the U.S. Patent and Trademark Office (Office). The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. This holds true for any day that the correspondence may be accepted as "Express Mail" by the USPS, even when the paper or fee is deposited and accepted

on a Saturday, Sunday or Federal holiday within the District of Columbia. For example, if a person files a patent application by "Express Mail" with the USPS on a Saturday in compliance with 37 CFR 1.10, he or she will receive the benefit of the Saturday date, even though the Office is closed on Saturdays and, therefore, the person could not have filed the application by depositing it directly at the Office on that Saturday. See 37 CFR 1.6(a)(1). In those cases where the procedure of 37 CFR 1.10(a) has not been properly followed, e.g., the "date-in" is illegible, the filing date of the correspondence will be the date of actual receipt in the Office. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d) or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

II. DATE-IN, DIRECT DEPOSIT, "EXPRESS MAIL" BOX RECEPTACLES & LOG BOOKS

The procedure in 37 CFR 1.10(a) requires the use of the "Express Mail Post Office to Addressee" service of the USPS. This service provides for the use of a mailing label on which the USPS clearly indicates the date on which it was deposited. Correspondence sent by the "Express Mail Post Office to Addressee" service is considered filed in the Office on the "date-in" entered by the USPS. The "date-in" on the "Express Mail" mailing label must be completed by the USPS, not by the applicant. For correspondence filed in accordance with 37 CFR 1.10, Office personnel will routinely look to the "Express Mail" mailing label, and stamp the "date-in" or other official USPS notation as the filing date of the correspondence. Accordingly, if the USPS enters the deposit date as its "date-in," the correspondence will receive the deposit date as its filing date. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d), * (e)>, (g), (h), or (i)< (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

37 CFR 1.10(b) further provides that correspondence should be deposited directly with an employee

of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. On petition, the failure to obtain an "Express Mail" receipt with the "date-in" clearly marked may be considered an omission that could have been avoided by the exercise of due care, as discussed below. While the Office strongly urges direct deposit of "Express Mail" correspondence in order to obtain a legible copy of the "Express Mail" mailing label, parties are not precluded from using "Express Mail" drop boxes, but do so at their own risk.

A paper or fee placed in an "Express Mail" box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt ("date-in") indicated on the "Express Mail" mailing label by the Postal Service "Express Mail" acceptance clerk. 37 CFR 1.10(d) permits the Office to correct a USPS "date-in" error when the correspondence is deposited in an "Express Mail" drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the "Express Mail" drop box indicating when the box will be cleared for the last time on the date of deposit. 37 CFR 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 CFR 1.10(c), (d), * (e)>, or (g)<. Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of

deposit; the depositor's initials or signature; and the date and time of entry in the log.

III. "EXPRESS MAIL" MAILING LABEL NUMBER

Effective December 2, 1996, 37 CFR 1.10(b) no longer requires a certificate of mailing by "Express Mail" or that the "Express Mail" mailing label number be placed on the correspondence prior to mailing. Correspondence deposited with the USPS on or after December 2, 1996, and which is actually received by the Office will not be denied a filing date as of the "date-in" appearing on the "Express Mail" mailing label because the number of the "Express Mail" mailing label was not placed on the correspondence prior to the original mailing. However, if the number of the mailing label did not appear on the correspondence as originally filed, relief will not be granted on petition under 37 CFR 1.10(c) **>, (d), (e), (g) or (h)<, even if the party who filed the correspondence satisfies the other requirements of 37 CFR 1.10(c), 1.10(d) * 1.10(e)>, 1.10(g), or 1.10(h)<. To be effective, the number must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached thereto. In situations wherein the correspondence includes several papers directed to the same application (for example, the specification, drawings, and declaration for a new application), the correspondence may be submitted with a cover or transmittal letter which should itemize the papers. It is not necessary that the number be placed on each page of a particular paper or fee transmittal. Merely placing the number in one prominent location on each separate paper or fee transmittal (or cover sheet or transmittal letter which should itemize the separate papers and fees) will be sufficient.

Since the filing of correspondence under 37 CFR 1.10 without the number of the "Express Mail" mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition. A party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148, nor is such an inadvertent omission considered "unavoidable," within the meaning of 15 U.S.C. 1062(b), 35 U.S.C.

133, 37 CFR 1.137(a) or 37 CFR 2.66(a). See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail."); *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir. 1996); *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183.); *Vincent v. Mossinghoff*, 230 USPQ 621 (D.D.C. 1985) (misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pat. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

IV. PETITIONS

37 CFR 1.10(c) through 1.10(e) >and 1.10(g)< set forth procedures for petitioning the Director to accord a filing date as of the date of deposit as "Express Mail." Briefly, 37 CFR 1.10(c) applies where there is a discrepancy between the filing date accorded by the Office and the "date-in" entered by the USPS on the "Express Mail" mailing label or other official USPS notation; 37 CFR 1.10(d) applies where the "date-in" is incorrectly entered by the USPS; * 37 CFR 1.10(e) applies where correspondence deposited with the USPS as "Express Mail" is not received by the Office>; and 37 CFR 1.10(g) applies where correspondence deposited with the USPS as "Express Mail" was returned by the USPS due to an interruption or emergency in "Express Mail" service.

37 CFR 1.10(h) and 1.10(i) set forth procedures for petitioning the Director when correspondence was

attempted to be deposited as "Express Mail." 37 CFR 1.10(h) applies where correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service; and 37 CFR 1.10(i) applies where correspondence was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director.<

V. PETITION TO CORRECT FILING DATE AND DATE-IN DISCREPANCY

37 CFR 1.10(c) sets forth procedures for filing a petition to the Director for a filing date as of the date of deposit with the USPS, where there is a discrepancy between the filing date initially accorded by the Office and the "date-in" entered by the USPS or other official USPS notation. Such a petition should:

- (A) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
- (B) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing; and
- (C) include a true copy of the "Express Mail" mailing label showing the "date-in" or other official notation by the USPS.

VI. PETITION TO CORRECT INCORRECTLY ENTERED DATE-IN

37 CFR 1.10(d) sets forth procedures for filing a petition to the Director to accord a filing date as of the actual date of deposit with the USPS, where the "date-in" or other official notation is incorrectly entered by the USPS. Such a petition should:

- (A) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
- (B) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing; and
- (C) include a showing that the correspondence was deposited as "Express Mail" prior to the last scheduled pickup on the requested filing date.

The showing under 37 CFR 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being after deposit and within one business day of the deposit of the correspondence as "Express Mail." Evidence from the USPS may be the "Express Mail" Corporate Account Mailing Statement. Evidence that came into being within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

The reason the Office considers correspondence to have been filed as of the date of deposit as "Express Mail" is that this date has been verified by a disinterested USPS employee, through the insertion of a "date-in," or other official USPS notation, on the "Express Mail" mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day after the deposit of the correspondence as "Express Mail."

A petition alleging that the USPS erred in entering the "date-in" will be denied if it is supported only by evidence (other than from the USPS) which was:

- (A) created prior to the deposit of the correspondence as "Express Mail" with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence); or
- (B) created more than one business day after the deposit of the correspondence as "Express Mail" (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as "Express Mail").

On the other hand, a notation in a log book, entered after deposit by the person who deposited the correspondence as "Express Mail" within one business day

of such deposit, setting forth the items indicated above, would be deemed on petition to be an adequate showing of the date of deposit under 37 CFR 1.10(d)(3).

37 CFR 1.10(d)(3) further provides that a party must show that correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date.

VII. PETITION FOR CORRESPONDENCE NEVER RECEIVED

37 CFR 1.10(e) sets forth procedures for filing a petition to the Director to accord a filing date as of the date of deposit with the USPS, where correspondence deposited as "Express Mail" is never received by the Office. Such a petition should:

(A) be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(B) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing;

(C) include a true copy of the originally deposited correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in" or other official notation entered by the USPS; and

(D) include a statement, signed by the person who deposited the documents as "Express Mail" with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying the petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received.

37 CFR 1.10(e) provides for the filing of a petition to accord correspondence a filing date as of the date of deposit with the USPS as "Express Mail" only where the correspondence was mailed with sufficient postage and addressed as set out in 37 CFR 1.1(a). There is no corresponding provision that correspondence be properly addressed and mailed with sufficient postage in 37 CFR 1.10(a), (c) and (d), because

these sections apply only to correspondence that is actually received by the Office. Correspondence mailed by "Express Mail" that is actually received by the Office will not be denied a filing date as of the date of deposit as "Express Mail" simply because the correspondence was not mailed with sufficient postage or not addressed as set out in 37 CFR 1.1(a). 37 CFR 1.10(e)(3) provides that if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label, the petition should include a showing under 37 CFR 1.10(d)(3), as discussed above, that the correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date. 37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost *in toto* (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

VIII. ADDITIONAL EVIDENCE MAY BE REQUIRED

37 CFR 1.10(f) provides that the Office may require additional evidence to determine whether the correspondence was deposited as "Express Mail" with the USPS on the date in question.

>

IX. PETITION FOR CORRESPONDENCE RETURNED DUE TO POSTAL INTERRUPTION OR EMERGENCY

37 CFR 1.10(g) provides that any person who mails correspondence addressed as set out in 37 CFR 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence returned by the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider the correspondence as filed on a particular date in the Office. Such a petition must:

- (A) be filed promptly after the person becomes aware of the return of the correspondence;
- (B) include a showing that the number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;"
- (C) include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in;" and
- (D) include a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or the copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date.

The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in "Express Mail" service. For example, the Office may require a letter from the USPS confirming that the return was due to an interruption or emergency in the "Express Mail" service.

This procedure does not apply where the USPS returned the "Express Mail" for a reason other than an interruption or emergency in "Express Mail" service such as the address was incomplete or the correspondence included insufficient payment for the "Express Mail" service.

X. PETITION FOR CORRESPONDENCE REFUSED DUE TO POSTAL INTERRUPTION OR EMERGENCY

37 CFR 1.10(h) provides that any person who attempts to mail correspondence addressed as set out in 37 CFR 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider the correspondence as filed on a particular date in the Office. Such a petition must:

- (A) be filed promptly after the person becomes aware of the refusal of the correspondence;
- (B) include a showing that the number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail;"
- (C) include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and
- (D) include a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service. For example, the Office may require a letter from the USPS confirming that the refusal was due to an interruption or emergency in the "Express Mail" service.

This procedure does not apply where the USPS refused the "Express Mail" for a reason other than an interruption or emergency in "Express Mail" service such as the address was incomplete or the correspondence included insufficient payment for the "Express Mail" service. In addition, this procedure does not apply because an "Express Mail" drop box is unavailable or a Post Office facility is closed.

XI. PETITION FOR CORRESPONDENCE UNABLE TO BE DEPOSITED DUE TO A DIRECTOR-DESIGNATED POSTAL INTERRUPTION OR EMERGENCY

37 CFR 1.10(i) provides that any person attempting to file correspondence by "Express Mail" that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director may petition the Director to consider such correspondence as filed on a particular date in the Office. Such a petition must:

- (A) be filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service;
- (B) include the original correspondence or a copy of the original correspondence; and

(C) include a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

This procedure applies only when the Director designates an interruption or emergency in "Express Mail" service. In the notice designating the interruption or emergency the Director will provide guidance on the manner in which petitions under 37 CFR 1.10(i) should be filed. The notice will be placed on the USPTO web site at www.uspto.gov and published in the *Official Gazette*.<



EXHIBIT G

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,135,862 B2
DATED : November 14, 2006
INVENTOR(S) : Teruhiko Hagiwara

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

At item "(22) Filed:" on the face of the patent, replace --Mar. 13, 2001-- with --Mar. 12, 2001--.

MAILING ADDRESS OF SENDER:
JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939
NYI-3976090v1
FORM PTO 1050

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